

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 18, 2004. Applicants have amended Claims 1, 2, 5, 6, 9, 11, 14, 15, 18-20, 22, 31, 32, 35, 37, 39 and 42, and have canceled Claims 24-30. Applicants respectfully request reconsideration and favorable action in this case in view of the following remarks.

Section 102(e) Rejections

The Examiner rejects Claims 1-5, 9-14, 17, 31-35 and 37-43 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,298,328 issued to Healy et al. ("*Healy*"). Applicants respectfully traverse these rejections for the reasons stated below.

Independent Claim 1, as amended, recites "associating a value stream having a plurality of value stream components with a plurality of industry segments . . ." (Emphasis added.) *Healy* does not teach or suggest this limitation because *Healy* is directed towards a market size analysis tool that "allocates, tracks, and forecasts market data by product, geographic area, market segment, provider, and time period." (*Healy*, col. 1, lines 10-12). The "value stream" of a particular company or industry segment is unrelated to sizing a market based on these five dimensions. The value stream of an enterprise is simply not used to size markets, as in *Healy*. In fact, the value stream concept is neither disclosed, referred to, or suggested by *Healy*.

Examiner states at page 2 of the Office Action that "Healy et al. discloses a tool that analyzes the changes of industries and computes industry size in terms of revenue." However, as discussed above, *Healy* is merely directed towards a "market" size analysis tool. A market is not an industry. Examiner continues on page 2 stating that:

the tool collects data concerning the industry, stores this data in the databases of the systems along with weighting coefficients, and then uses this data to collect market allocations and revenues by product, the total revenue for the industry resulting from the sum of the revenues of the industry's products. The system also tracks historic and forecasted market data and assigns growth rates using this data. Therefore, since revenue itself is an inflow of assets that results from sales of goods and services, a tool that analyzes data elements of the market segment of a specific industry to determine the inflow of value satisfies the limitations of the claims.

Hence, the Examiner indicates that *Healy* sizes markets in terms of revenues. At best, this is akin to sizing markets based on net sales (i.e., revenues) shown in column 306 and/or gross

profit as indicated in column 308 of Applicant's Figures 3A-3J. The value stream components 304 shown in Applicant's Figures 3A-3J and recited in Claim 1 are not related to or associated with revenue, but expenditures. Thus, Applicants' invention as recited by Claim 1 is directed towards the analysis of one or more value stream components in order to determine resource allocation. Applicants respectfully submit that they believe the Examiner is confusing the value of a particular market with the value stream of a particular industry segment.

Therefore, *Healy* does not disclose or suggest a value stream having a plurality of value stream components, but merely dimensions of a market size. For at least this reason, *Healy* does not anticipate Claim 1.

For reasons analogous to those above, the rest of the limitations of Claim 1 are also not anticipated by *Healy*. In addition, independent Claim 9 recites "a database storing expenditures for a time period for a plurality of industry segments, expenditures associated with at least one of a plurality of value stream components . . .," independent Claim 31 recites, "associating a value stream having a plurality of value stream components with a plurality of industry segments, . . ." and independent Claim 37 recites, "a database storing expenditures for a time period for a first industry segment, the expenditures associated with at least one of a plurality of value stream components; . . ." *Healy* also does not anticipate Claims 9, 31 and 37 for reasons analogous to those above in conjunction with Claim 1. Therefore, Applicants respectfully request that the rejection of independent Claims 1, 9, 31 and 37 be withdrawn.

Dependent Claims 2-5 depend from independent Claim 1, dependent Claims 10-14 and 17 depend from independent Claim 9, dependent Claims 32-35 depend from independent Claim 31, and dependent Claims 38-43 depend from independent Claim 37, and are also not anticipated by *Healy* because they include the limitations of their respective base claim (which are shown above to be allowable) as well as further limitation(s) that further distinguish *Healy*. Therefore, Applicants respectfully request that the rejection of Claims 2-5, 10-14, 17, 32-35 and 38-43 be withdrawn.

Section 103(a) Rejections

The Examiner rejects Claims 6-7, 15-16 and 36 under 35 U.S.C. § 103(a) as being unpatentable over *Healy*. Claims 6-7 depend from independent Claim 1, Claims 15-16 depend from independent Claims 9, and Claim 36 depends from independent Claim 31. These claims are not rendered obvious by *Healy* because they include the limitations of their respective base claim (which are shown above to be allowable) as well as further limitation(s) that further distinguish *Healy*. Therefore, Applicants respectfully request that the rejection of Claims 6-7, 15-16 and 36 be withdrawn.

In addition to depending from allowable independent claims, dependent Claims 6 and 15 are allowable for the following additional reason. Dependent Claims 6 and 15 recite specific value stream components, which *Healy* does not disclose, teach or suggest. The Examiner states at page 12 of the Office Action that:

Healy et al. discloses different components of a value stream that are analyzed, these components related to product, market, geographic area, customer, etc. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the components of Claims 6 and 15 in the components disclosed by *Healy et al.* and used for analysis in order to enhance the scope and scale of analysis performed by incorporating all the factors that drive the size of the market for a 'product'.

However, as discussed above, *Healy* does not disclose different components of a value stream. In addition, the value stream components recited in dependent Claims 6 and 15 do not drive the size of the market for a product, as alleged by the Examiner. If the Examiner believes Applicants are incorrect, then Applicants respectfully ask the Examiner to present a reference that supports her position.

In addition, Applicants respectfully submit that the required motivation to modify *Healy* with respect to dependent Claims 6 and 15, has not been provided. The Examiner merely states a perceived advantage of modifying *Healy*. No other evidence is provided. This certainly falls short of providing evidence that is "thorough and searching," as mandated by the Federal Circuit. *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Thus, Applicants respectfully submit that dependent Claims 6 and 15 is allowable for this additional reason. Reconsideration and favorable action are respectfully requested.

The Examiner also rejects Claims 18-30 under 35 U.S.C. § 103(a) as being unpatentable over *Healy* in view of NAICs Association (www.naics.com). Applicants respectfully traverse these rejections for the reasons stated below.

Applicants have canceled Claims 24-30, which renders the rejections of these claims moot. Also, with respect to Independent Claim 18, Claim 18 is not rendered obvious by *Healy* and NAICs Association, either alone or in combination, because of reasons analogous to those above in conjunction with Claims 1, 9, 31 and 37 with respect to *Healy* and because NAICs Association also does not disclose or suggest the use of the value stream having a plurality of value stream components. Therefore, neither *Healy* or NAICs Association teach or suggest all the claim limitations of independent Claim 18. Thus, a *prima facie* case of obviousness has not been established and neither *Healy* nor NAICs Association, alone or in combination, renders obvious independent Claim 18. Applicants respectfully request the rejection of these independent claims be withdrawn.

Dependent Claims 19-23 depend from independent Claims 18 and 24, and are also not rendered obvious by *Healy* or NAICs Association, alone or in combination, because each dependent claim includes the limitations of Claim 18 (which is shown above to be allowable) as well as further limitation(s) that further distinguish *Healy* and NAICS Association. Therefore, Applicants respectfully request that the rejection of Claims 19-23 be withdrawn.

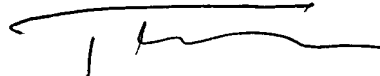
CONCLUSIONS

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, if a fee is due, the Commissioner is hereby authorized to charge any required fees to deposit account number **05-0765** of **Electronic Data Systems Corporation.**

Respectfully submitted,

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